

REMARKS

This paper is filed in response to the official action dated November 15, 2006 (hereinafter, the official action).

The applicants first thank the examiner for his time in answering the applicants' questions regarding the rejections.

Claims 54-69 were pending. Claims 64-69 were withdrawn. Claims 54-60 and 62-63 have been rejected. Claim 61 has been objected to, but is allowable in substance. By this amendment, claims 54 and 56-58 are amended, claims 64-69 are canceled and new claim 70 is added. Support for the amendments to the claims and the new claim may be found in the specification as originally filed. No new matter is added. As a result, claims 54-63 and 70 are pending and at issue.

Claim 70 is previously allowable claim 61 rewritten in independent form. Thus, the applicants respectfully request allowance of claim 70.

Claims 54-59, 62, and 63 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,911,569 to Hashimoto et al. ("Hashimoto"). Claim 60 has been rejected under 35 U.S.C. §103(a) as obvious over Hashimoto in view of U.S. Patent No. 4,617,697 David ("David").

Responses to the claim rejections are addressed below in the order presented in the official action. Reconsideration of the application, as amended, is solicited in view of the following remarks.

RESPONSE TO 35 U.S.C. § 102 REJECTIONS

The applicants respectfully traverse the rejections of claims 54-59, 62, and 63 as anticipated by Hashimoto. It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. *See, e.g., C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity. *Id.* This standard has not been satisfied with respect to claims 54-59, 62, and 63.

Each of claims 54-59, 62, and 63 recites a writing instrument comprising a deformable sleeve having a generally tubular base with a first diameter, a generally tubular outer membrane with a second diameter larger than the first diameter and "an annular sealable passageway defined between adjacent, engaged ends of the tubular

base and outer membrane.” Hashimoto fails to disclose or suggest a writing instrument comprising “an annular sealable passageway defined between adjacent, engaged ends of a base and an outer membrane,” as recited in claims 54-59, 62 and 63.

Moreover, Hashimoto discloses a writing instrument comprising an elastic envelope 35 having an inner wall 44 and an outer wall 5 that are *separated* by a front end wall 45 at one end and one of an expandable portion 52 disposed opposite the front end wall (see Figs. 9-11, col. 10, lines 23-38), an extension 36 (see Figs. 12-13 and col. 12, lines 4-11), and an extension 37 (see Figs. 14 and 15 and col. 12, lines 21-29). In other words, in each of the embodiments shown in Hashimoto, the *ends* of the inner wall 44 and the outer wall 5 are not “engaged,” as recited in each of pending claims 54-59, 62, and 63.

Hashimoto further discloses a fluid chamber 6 (identified in the official action at page 3 as a passageway), formed by the inner and outer walls 44, 5, the front end wall 45 and one of the expandable portion 52 and the extensions 36, 37, and filled with fluid through a normally disclosed inlet formed in the outer wall 5 (see, e.g., Fig. 9 and col. 10, lines 27-32), or extensions 36 and 37, respectively. This is unlike the “annular sealable passageway defined between the adjacent, engaged ends of the tubular base and the outer membrane,” as recited in each of the pending claims, which accepts a tube for injecting fluid into the cavity. See Application, Fig. 7A and page 24, lines 19-21 (“A small tube [not shown] can be used to inject the formable material 310 between the ends 320 and 322...and into the cavity.”). More specifically, because the ends of the inner wall 44 and the outer wall 5 in Hashimoto fail to engage each other because they are *physically separated* by the front end wall 45 and the rear end wall 54, for example, there is no annular sealable passageway defined between adjacent, engaged ends. See, e.g., Fig. 9 and col. 10, lines 33-37.

In view of the foregoing, Hashimoto fails to anticipate each of claims 54-59, 62, and 63. Thus, the applicants respectfully request withdrawal of the rejection and allowance of claims 54-59, 62, and 63.

RESPONSE TO 35 U.S.C. § 103 REJECTION

The applicants respectfully traverse the rejection of claim 60 as obvious over Hashimoto in view of David (collectively the “cited art”). Neither Hashimoto nor

David, alone or in combination, discloses or suggests a writing instrument having an “annular sealable passageway defined between adjacent, engaged ends of a tubular base and an outer membrane in fluid communication with the cavity,” as recited in claim 60.

A *prima facie* case of obviousness must satisfy three legal requirements. First, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See M.P.E.P. §2143. These criteria have not been satisfied with respect to pending claims 60. In particular, the prior art references fail to teach or suggest all of the claim limitations.

As explained above, Hashimoto discloses a writing instrument comprising an elastic envelope 35 having an inner wall 44 and an outer wall 5 that are physically separated by a front end wall 45 and one of an expandable portion 52, an extension 36, and an extension 37. Thus, Hashimoto does not disclose or suggest engaged ends of the inner and outer wall or “an annular sealable passageway defined between adjacent, engaged ends,” as recited in claim 60.

David fails to address the deficiencies of Hashimoto. David discloses a moldable handle adapter for golf clubs and tennis rackets; the David device is essentially a closed pouch having two sections, a larger section 10 and a smaller section 12 joined by a lap joint 14 (col. 2, lines 21-24; see also Fig. 1). David teaches that the overlapping walls 16 and 18 should form a strong lap joint that is closed and impenetrable (see, e.g., col. 2, lines 40-43 and col. 5, lines 31-34), and, thus, does not provide an “annular sealable passageway defined between adjacent, engaged ends of a base and an outer membrane in fluid communication with a cavity,” as recited in claim 60.

Because neither Hashimoto nor David discloses or suggests “an annular sealable passageway defined between adjacent, engaged ends of a base and an outer membrane,” as recited in claim 60, no combination of Hashimoto and David can render claim 60 obvious. Thus, the applicants respectfully request withdrawal of the rejection, and allowance of claim 60.

CONCLUSION

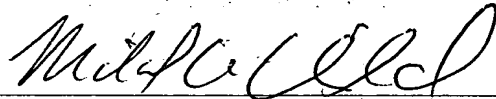
In light of the foregoing amendments and remarks, reconsideration and allowance of pending claims 54-63 are respectfully solicited. Enclosed is a Request for Continued Examination and a check in the amount of \$790.00 to cover the requisite fee. No other fees are believed due. However, if there are any other fees or refunds required, the Director's designee is authorized to charge or debit Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned at the indicated telephone number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

February 15, 2007



Michael A. Chinlund, Reg. No. 55,064
Agent for Applicants
6300 Sears Tower
233 S. Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300